

**REMARKS**

This Amendment and Reply seeks to place this application in condition for allowance.

Certain claims have been amended to more clearly describe, to more fully protect the invention and to correct the dependency of one of the claims. None of these amendments were motivated by patentability considerations in view of the prior art, including the art presented/cited in the Office Action of October 5, 2005 (hereinafter the "Office Action"). No new matter has been added. Further, the Applicant has added three (3) new claims to more fully protect the instant invention. No new matter has been added.

**Office Action of October 5, 2005**

In the Office Action, the Examiner raised an issue regarding priority, rejected certain claims on the basis of nonstatutory double patenting over certain claims of U.S. Patent 6,662,038 and rejected certain claims as being anticipated by or obvious in view of Wang et al., U.S. Patent 6,230,040 and U.S. Patent 5,827,187. Each rejection will be addressed in the order presented in the Office Action.

**Double Patenting Rejections**

Certain claims were rejected under the judicially created doctrine of obviousness-type double patenting. In an effort to expedite the prosecution of the instant application, Applicant submits herewith a Terminal Disclaimer, executed by the attorney of record, to address those rejections. This Terminal Disclaimer is submitted to obviate all of the double patenting rejections. It is believed that the Terminal Disclaimer complies fully with the relevant parts of 37 CFR 1.321.

**Claim of Priority**

In the Preliminary Amendment filed concurrently with the instant application, applicant amended the specification to provide the status of the continuation data.<sup>1</sup> In this regard, on page 2 of the Preliminary Amendment, the specification of the instant application was amended in the following manner:

Please **replace** the paragraph on page 2, line 2, with the following paragraph:

This application is a continuation of Application Serial No. 09/828,428 (still pending), filed April 7, 2001, which is a continuation of Application Serial No. 09/124,262, filed July 29, 1998, now U.S. Patent 6,230,041, which is a continuation of Application Serial No. 08/715,736, filed September 19, 1996, now U.S. Patent 5,799,649, which is a continuation of Application Serial No. 08/420,815, filed April 12, 1995, now U.S. Patent 5,579,767, which is a continuation-in-part of Application Serial No. 08/378,384, filed January 25, 1995, now U.S. Patent 5,553,619; which is a continuation-in-part of Application Serial No. 08/071,970, filed June 7, 1993, now U.S. Patent 5,417,213.

As such, the instant application was amended, via the Preliminary Amendment, to reflect the relationship to Application Serial No. 09/828,428, Application Serial No. 09/124,262, Application Serial No. 08/715,736, and Application Serial No. 08/420,815,

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<sup>1</sup> For the convenience of the Examiner, the undersigned has attached a highlighted print-out of the "Image File Wrapper" found on the USPTO's Public PAIR database wherein on page 1 of the print-out the Applicant's amendment to include the continuation data statement is found under the Document Description "Specification", Mail Room Date "8-26-2003", Page Count "1".

(among others). The instant application has now been amended to reflect the fact that Application Serial No. 09/828,428 issued (after submission of the Preliminary Amendment) as U.S. Patent 6,662,038. In this way, the claim of priority is more fully perfected. (See, 35 USC 121). Accordingly, the instant application is entitled to a priority date of no later than filed April 12, 1995, by virtue of the relationship to Application Serial No. 08/420,815, now U.S. Patent 5,579,767.<sup>2</sup>

In sum, it is respectfully requested that the complete priority claim be acknowledged in the next Action.

#### **Claim Objection**

The undersigned appreciates the Examiner's detailed and thorough review of the claims. Claim 34 has been amended to correct an inadvertent error in its claim dependency. No new matter has been added.

#### **Claim Rejection -- §§ 102 and 103**

Certain claims were rejected as being anticipated by or obvious in view of Wang et al., U.S. Patent 6,230,040 and U.S. Patent 5,827,187. However, the Wang et al. patents are not prior art to the pending claims. (See, 35 USC § 102). As discussed above, the claims of the instant application are entitled to a priority date of no later than April 21, 1995. The Wang et al. patents (U.S. Patent 6,230,040) and (U.S. Patent 5,827,187) were filed on November 21, 1997 and October 30, 1996, respectively. Wang et al., U.S. Patent 5,827,187, claims priority to a Provisional Application filed on April 23, 1996. As such, the

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<sup>2</sup> No inference or conclusion should be drawn that April 21, 1995 is the earliest priority date of the claims of the instant application.

Wang et al. patents were filed well after April 21, 1995 – the latest priority date of the claims of the instant application.<sup>3</sup>

Notably, no inference or conclusion should be drawn that Applicant agrees, in any way, with the Examiner's characterization of the Wang et al. patents, or the application of the claims to the Wang et al. patents. In an effort to provide a more concise statements, and because this rejection is overcome, without more, via clarification of the priority date of the instant application, Applicant does not provide substantive remarks regarding the merits of the rejection.

#### **CONCLUSION**

Applicant respectfully requests entry of the foregoing amendments and reconsideration of the application. Applicant submits that all of the pending claims present patentable subject matter. Accordingly, allowance of the claims is respectfully requested.

It is noted that should a telephone interview expedite the prosecution of this application in any way, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: October 24, 2005

Neil Steinberg, Reg. No. 34,735  
Telephone No.: 650-968-8079

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<sup>3</sup> As mentioned above, no inference or conclusion should be drawn that April 21, 1995 is the earliest priority date of the claims of the instant application.

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10/648,167 Method for imaging an artery using a magnetic resonance contrast agent

Image File Wrapper

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